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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/456,042	12/06/1999	ROBERT F. BONNER	15280-347100	5889

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EXAMINER

GABEL, GAILENE

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 10/03/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/456,042

Applicant(s)

BONNER ET AL.

Examiner

Gailene R. Gabel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 16-46 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 and 13 is/are allowed.
- 6) ☒ Claim(s) 1-7,9-12,14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-46 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Amendment Entry

1. Applicant's amendment and response filed 5/19/03 in Paper No. 17 is acknowledged and has been entered. Claims 1, 3, 5, 7-10, 12, and 14 have been amended. Currently, claims 1-46 are pending. Claims 1-15 are under examination.

Rejection Maintained

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-7, 9-12, 14, and 15 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is being maintained for reasons of record and reiterated as follows.

Claim 1, "providing step" is ambiguous because it is unclear as to whether it is "activation" that specifically causes volumetric expansion of the selectively activatable layer or the "becoming adhesive to a portion of the specimen" that causes the volumetric expansion of the selectively activatable layer. It appears that selective activation should cause both of the volumetric expansion and adhesion ... to a portion of the specimen.

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Claim 5 is confusing in reciting, "... having the steps of: the step of providing a selectively activatable layer includes the step of". It is unclear how the step of "providing a selectively activatable layer" specifically includes the step of "placing a coating". Thus, it remains unclear at what point in claim 1 from which it depends the step of "placing the coating on one side of the selectively activatable layer" is performed. Specifically, if the selectively activatable layer is provided with a coating on one side of the layer, or if a coating having an affinity specific bond is incorporated on one side of the selectively activatable layer, then such [limitation] should be recited as such.

Claim 5 remains confusing and appears redundant in relation to claim 1 because it is unclear at what point in claim 1 from which it depends the step of "exposing the selectively activatable layer at the coating to the specimen" is performed. It is specifically unclear how this instant step relates functionally to the step of "placing ... and overlaying the selectively activatable layer to a finite distance from the specimen" in claim 1.

Claim 5 is confusing in reciting, "... having the steps of: ... the selectively activating step includes activating the selectively activatable layer to cause the coating having the having the affinity specific bond to contact the specimen". It is unclear how the "selectively activating step" in claim 1, includes "activating the selectively activatable layer to cause ...". It is specifically unclear at what point in claim 1 this step of "activating the selectively activatable layer to cause the coating having the having the affinity specific" is performed distinctly and inclusively so as to clearly relate to claim 1.

Claim 9 is confusing and appears redundant in relation to claim 8 from which it depends in reciting, "allowing the heated selectively activatable layer to cool and elastically contract the extremity towards the activatable layer ..." because it is unclear how this step is distinct from the step of "allowing the heated selectively activatable layer to cool and elastically contract the extremity towards the activatable layer ..." in claim 8, to thus cause a portion of the specimen to be microdissected as recited in claim 9.

Claim 10 is indefinite and appears redundant in relation to claim 8 from which it depends in reciting, "contracting the volumetric expansion by cooling while maintaining attachment ... to elastically tension the volumetric expansion" because it appears that the "allowing the heated selectively activatable layer to cool and elastically contract" in claim 8 already contracts the selectively activatable layer to thus cause a portion of the specimen to be microdissected upon withdrawal as recited in claim 10.

Claim 11 is vague and indefinite in relation to claim 8 from which it depends because it is unclear at what point in claim 8 the step of "contracting the volumetric expansion at the extremity to withdraw the portion of the specimen bonded to the volumetric expansion ..." is performed since it appears to duplicate "allowing the heated selectively activatable layer to cool and elastically contract the extremity towards the activatable layer ..." recited in claim 8 as a separate method step but including further limitations.

Claim 12 lacks clear antecedent support in relation to claim 8 in reciting, "providing activatable layer with ...". It is specifically unclear how this instant step

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relates structurally, functionally, and cooperatively, to the step of "providing a selectively activatable layer..." in claim 8 since it is being claimed as a separate method step.

Perhaps Applicant intends "wherein the activatable layer is provided with volume change associated with phase transition".

Claim 14 is ambiguous in reciting, "activation by laser causes volumetric expansion upon heating beyond a first interval" because it is unclear what is encompassed, i.e. unit of measure for heat, by the recitation of "upon heating beyond a first interval". Does Applicant intend, "activation by laser causes volumetric expansion beyond a first interval upon heating". Additionally, claim 14 is indefinite for being subjective in reciting, "with respect to a specimen".

In sum, it is noted that the dependent claims in the claimed inventions, which intend to recite further limitations are replete with what appears to be redundant recitations of method steps, and only including further limitations thereto. These redundancies have rendered the claims vague, indefinite, and confusing because they are read as separate method steps in addition to those recited in the base claims.

Allowable Subject Matter

3. Claims 8 and 13 are allowable. Claims 1-7, 9-12, and 15 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action.

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4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gailene R. Gabel whose telephone number is (703) 305-0807. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0169.

Gailene R. Gabel
Patent Examiner
Art Unit 1641
September 22, 2003

GH

Christopher L. Chin

CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1800-1641